UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SUNDARAM RAMAKESAVAN

Appeal 2007-1337
Application 09/234,559
Technology Center 2600

Decided: May 30, 2007

Before JAMES D. THOMAS, JOSEPH F. RUGGIERO, and ANITA PELLMAN GROSS, *Administrative Patent Judges*.

GROSS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Ramakesavan (Appellant) appeals under 35 U.S.C. § 134 from the Examiner's Final Rejection of claims 1 through 20, 23, 25, and 26, which are all of the claims pending in this application.

Appellant's invention relates to a video distribution system and method which permits a user to pause a received video, obtain an

authorization code from the video transmitter, and resume from the same place at a later time by providing the authorization code. Claim 4 is illustrative of the claimed invention, and it reads as follows:

4. A video transmission system comprising:

a video transmitter that transmits video to a plurality of receivers for display at a later time; and

a controller that transmits decryption information to said receivers to enable video upon request, said controller receives a request for a code to enable the play of video to be paused and to be resumed at a later time, and in response said controller automatically provides said code.

No prior art references have been relied upon by the Examiner in rejecting the appealed claims.

Claims 1 through 20, 23[1], 25, and 26 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description and enablement requirements.

We refer to the Examiner's Answer (mailed August 28, 2006) and to Appellant's Brief (filed October 16, 2006) and Reply Brief (filed October 10, 2006) for the respective arguments.

SUMMARY OF DECISION

As a consequence of our review, we will reverse the rejections of claims 1 through 20, 23, 25, and 26 under 35 U.S.C. § 112, first paragraph.

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[1] We note that although the Examiner has not rejected claims 23 and 25 under 35 U.S.C. § 112, second paragraph, claims 23 and 25 depend from claims 22 and 24, respectively, which have been canceled.

OPINION

The Examiner asserts (Answer 4) that nothing in Appellant's Specification "allows for any 'automatic' operations. Subsequent to an initial pause request, an actual resumption is done by a *manual* prompting of a key." Since the term "automatic" was added to each of independent claims 1, 4, 10, 14, 16, and 17 by amendment, the Examiner rejects all of the claims as failing to comply with the written description requirement.

Appellant contends (Br. 11) that "[t]he application discloses doing what is claimed using software. Necessarily that involves automatic operations." Referring to Figure 2, Appellant further contends (Br. 11 and Reply Br. 1-2) that block 42 indicates an automatic request for an authorization code in response to the user's pause request at diamond 40. The issue, thus, is whether Appellant's Specification provides adequate written description for the claimed automatic operations.

Appellant discloses (Specification 5:9-14) that "[t]he video provider (or other source) then may provide not only the decryption information, but . . . the information needed to access the receiver's memory for the selected video information . . . . This access information may be provided as script or other software." Also, Appellant states (Specification 6:6-8) that in Figure 2, software is stored on the receiver for implementing the video on demand system. Further referring to Figure 2, "[i]f the user wishes to pause the ongoing video transmission (diamond 40), a signal may be sent . . . to the video provider 14 requesting a pause authorization (block 42). The video provider may respond by providing an acknowledgement number (block 44)" (see Specification 7:11-16). Thus, in response to a manual pause request by a user, a signal is sent by the software stored on the receiver to

request an authorization code, and the code is returned to the user from the video provider by software. Thus, both the request for the code and the provision of the code are done automatically in response to the manual pause request. Accordingly, the Specification does provide adequate written description for the claimed automatic operations, and we cannot sustain the written description rejection of the claims.

The Examiner further rejects the claims for lack of enablement, asserting (Answer 4) that "[i]t is not clear from the claim context, nor in light of the original disclosure, how the system can 'automatically' request a code." The Examiner explains (Answer 5) that Figure 2 "correlates 'request code' 42 with a 'pause authorization' which one of ordinary skill in the art would understand as being a signal *manually* initiated by the user in the requesting of a pause." Further, the Examiner asserts that the disclosure gives no explanation as to what the acknowledgement number is and that the user manually provides the acknowledgement number with the resume request. The Examiner concludes (Answer 5) that "the claims are accordingly misdescriptive and are indefinite in scope because how an 'automatic' request is carried out is not understood nor explained as delimited by the claims."

Appellant contends (Br. 11-12) that the Specification provides that manual prompting by pausing the video initiates an automatic request for a code for the user to use to resume the video from the point where the pause was implemented. Appellant (Reply Br. 2) contends that the Specification states that when a pause is selected by a user, a signal is sent by the software, and the video provider responds by providing an acknowledgement number. Thus, the Specification clearly provides that the

claimed steps are done by software, and thus automatically. Further, Appellant adds (Br. 12) that "the assertions of indefiniteness under an enablement [rejection] are misplaced." The second issue before us is whether the claimed automatic operations are enabled by the disclosure.

We first note that Appellant is correct that statements of indefiniteness in a rejection under the first paragraph of 35 U.S.C. § 112 are misplaced. Second, the test of enablement is whether the skilled artisan could make or use the invention from the disclosure without undue experimentation. The Examiner must consider several factors in determining whether any necessary experimentation is "undue" and thus whether or not the claims are enabled. These factors include, but are not limited to: the breadth of the claims, the nature of the invention, the state of the prior art, the level of one of ordinary skill, the level of predictability in the art, the amount of direction provided by the inventor, the existence of working examples, and the quantity of experimentation needed to make or use the invention based on the content of the disclosure. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). We find no such analysis by the Examiner.

The flowchart of Figure 2 and the accompanying description of software sending a signal to request a code for the user to use to resume from the location of the pause clearly indicate that a request for a code is done automatically by software *in response* to a manual pause request by the user. Although the word automatic is not used in the Specification, and the disclosure could be more detailed, we find no undue experimentation necessary for the skilled artisan to make and use the claimed invention. In other words, the claimed automatic operations are enabled by the disclosure, and we cannot sustain the Examiner's enablement rejection.

ORDER

The decision of the Examiner rejecting claims 1 through 20, 23, 25, and 26 under 35 U.S.C. § 112, first paragraph, is reversed.

REVERSED

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